

REMARKS/ARGUMENTS

Applicant wishes to thank the Examiner for his careful consideration of the present application.

Status of the Claims

Claims 1-11 are pending in this application.

Claims 1, 4, 6, 7 and 11 are rejected.

Claims 8 and 9 are objected to.

Claims 2, 3, 5, and 10 are withdrawn.

Claims 4 and 7 are cancelled.

Claim 8 is amended.

The Examiner has rejected claims 1, 4, 6, 7 and 11 under 35 USC §103(a) as being obvious in view of Freda, U.S. Patent 3,365,024 in combination with Shepard, U.S. Patent 4,281,779. The Examiner states that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the outlet of Freda with the valve outlet as taught by Shepard. In light of the above amendments to the claims and the following remarks, Applicant respectfully requests reconsideration of the claims.

According to the Examiner, Freda shows, in Figs. 1-3, a device for applying a fluid onto a surface using a plurality of outlets arranged in the work surface for permitting transfer of the fluid to the surface. The outlets are radially spaced on the convex curved work surface for applying the fluid onto an external cylindrical surface of a workpiece. However, Freda fails to show a closure member in each outlet biased by a spring or other device but only specifies a pressure regulation device as a means of controlling the flow of the lubricant through each outlet.

According to the Examiner, Shepard shows, in Figs. 7-11, a device for applying a fluid onto a surface comprising a closure member biased by a spring. The closure member is configured to be pressed by the surface placing it from first position to second position – or from closed position to open position – upon contact with such surface. However, Shepard fails to show a plurality of outlets radially spaced (or

otherwise) on the convex curved work surface for applying the fluid onto an external cylindrical surface of a workpiece.

Applicant's invention – as claimed in independent claims 1 and 11 – shows, in Figs. 3-4, a device for applying fluid onto a surface comprising a plurality of closure members, each biased by a spring and a plurality of outlets radially spaced on a convex curved work surface. The plurality of spring biased closure members applies fluid onto the external cylindrical surfaces of a workpiece. The arrangement and design of the outlets also provides a more targeted application of a flowable medium, e.g., lubricating oil, onto a workpiece. This function is not anticipated or disclosed in any fashion in the Freda or Shepard references.

The combination of the two references is only obvious when the prior art either explicitly or implicitly teaches their combination. WMS Gaming v. International Game Technology, 184 F.3d 1339, 1355 (D.C. Cir. 1999)(quoting In re Beattie, 974 F.2d 1309, 1311-12 (D.C. Cir. 1992)("When determining the patentability of a claimed invention which combines two known elements, 'the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.' "). Neither Freda nor Shepard teach, motivate or suggest the combination of a plurality of outlets with spring biased closure members. Notwithstanding the applicant's invention, there is no suggestion in the prior art to combine the Freda reference with the Shepard reference.

Applicant's device is only obvious to a person of ordinary skill in the art when using Applicant's own reference as a road map and employing hindsight to combine the Freda reference and Shepard reference together. Such hindsight reconstruction is improper. Orthopedic Equipment Co., Inc. v. U.S., 212 U.S.P.Q. 523 (Ct. Cl. 1981).

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

W.L. Gore & Associates v. Garlock, 721 F.2d 1540, 1553 (D.C. Cir. 1983). Examiner's rejection under §103 can only be substantiated by demonstrating desirability *in the*


prior art to combine these references and not desirability in view of Applicant's own invention. See Ex parte Kice, 211 U.S.P.Q. 560 (PTO BA 1980). Such demonstration in this instance is not plausible since the Freda reference does not deal with a closure member biased by a spring nor does Shepard involve a plurality of outlets. As such, Applicant's disclosure is not obvious to a person of ordinary skill in the art and the rejection of the claims under 35 USC §103(a) must fail. Reconsideration is respectfully requested.

The Examiner has objected to claims 8 and 9 as being dependent upon a rejected independent claim. The Examiner states that claims 8 and 9 would be allowable if written in independent form. As reflected above, claim 8 has been amended to be written in independent form and includes all of the limitations of claims 1, 4, and 7. Therefore, claims 8 and 9 are now allowable.

Should the Examiner have any questions or suggestion, please call the undersigned attorney. The Applicant thanks the Examiner for his consideration of this application.

Please charge any cost incurred in the filing of this Amendment, along with any other costs, to Deposit Account 06-1510. If there are insufficient funds in this account, please charge the fees to Deposit Account No.06-1505.

Respectfully submitted,


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REPLACEMENT SHEET A



1/3

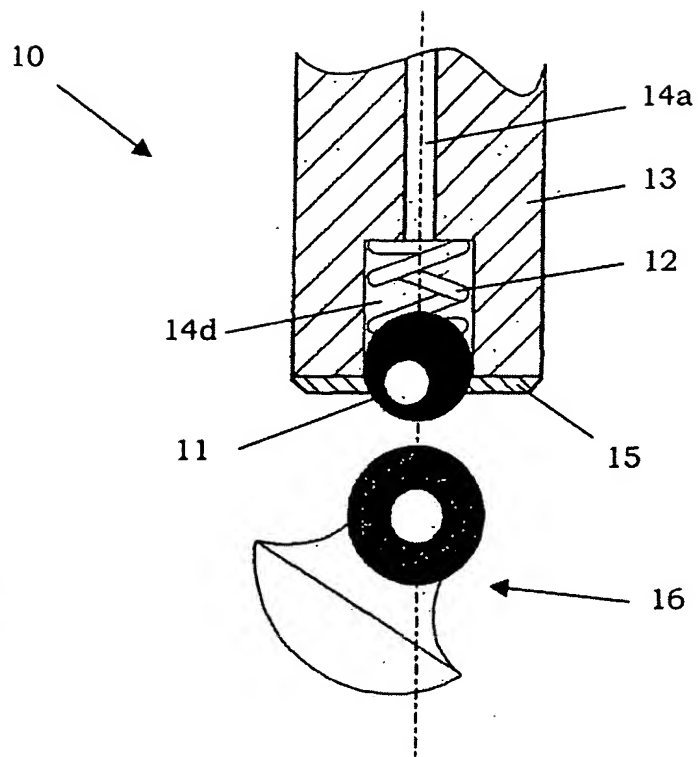


Fig. 1

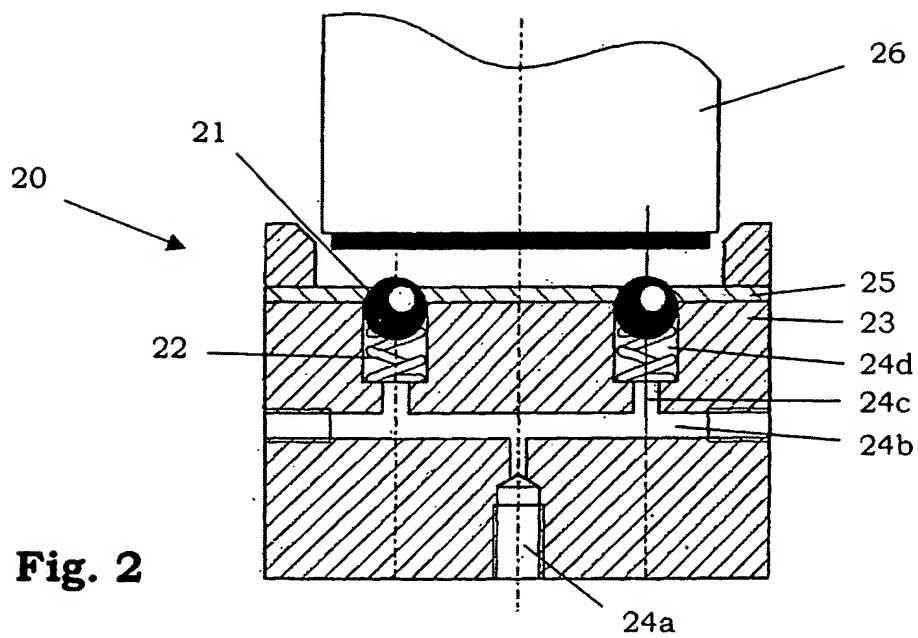


Fig. 2

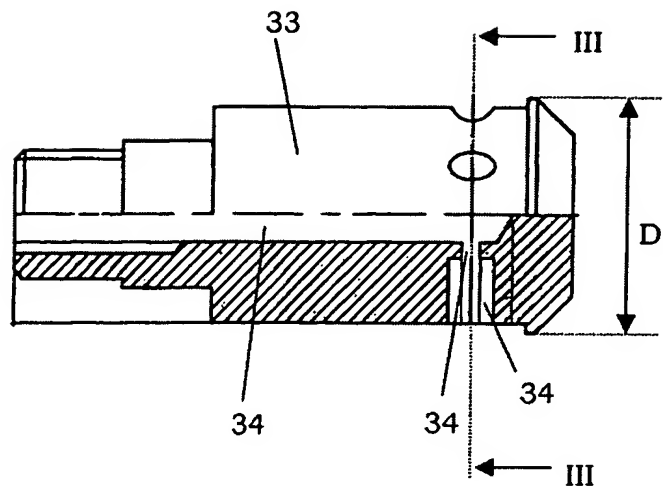
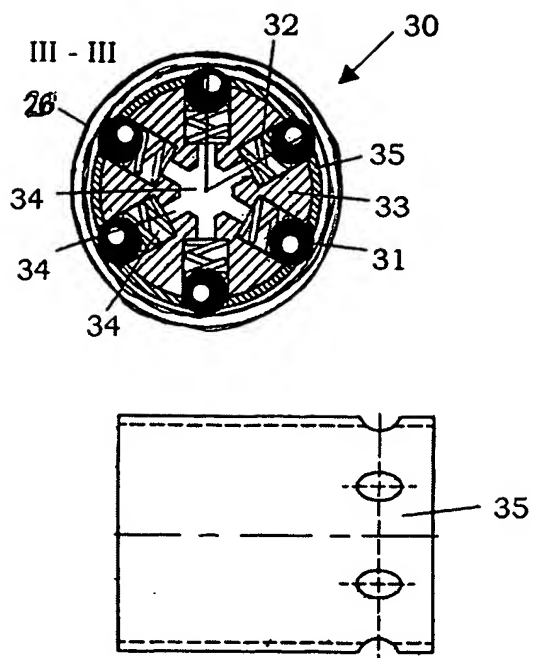


Fig.3

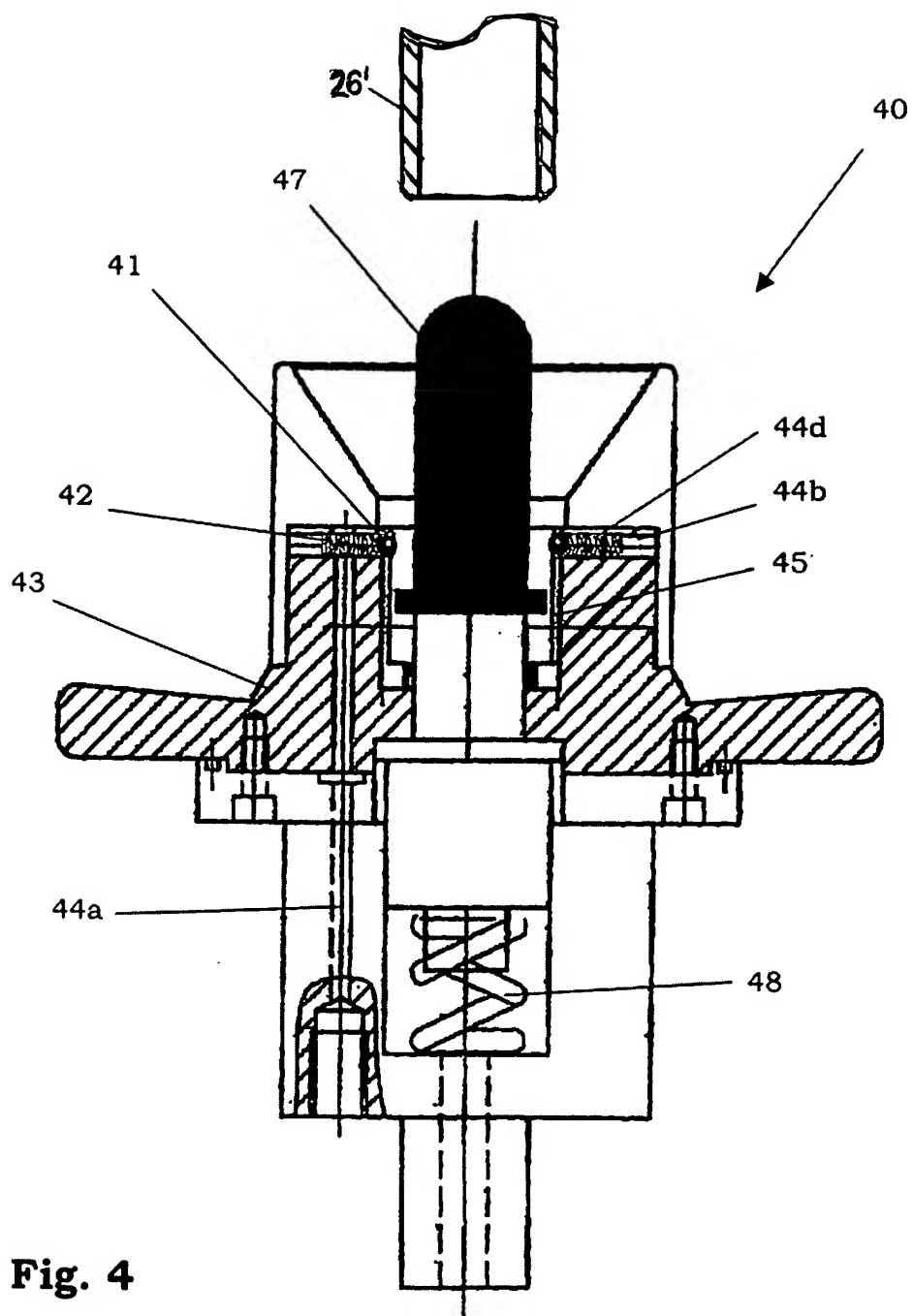


Fig. 4

REPLACEMENT SHEET B

Please delete paragraph 0039 and replace the entire paragraph with the following new paragraph:

Paragraph 0039. The device 30 which is illustrated in figure 3 is suitable for oiling cylindrical holes 26' whose inside diameter is larger than or equal to the outside diameter D of the device 30.

Please delete paragraph 0040 and replace the entire paragraph with the following new paragraph:

Paragraph 0040. Figure 4 illustrates a device with which cylindrical outer surfaces of sleeves 26', for example of an oil filler neck, can be oiled. Identical parts are again provided with corresponding reference numbers, beginning at the number 40.

Please delete paragraph 0042 and replace the entire paragraph with the following new paragraph:

Paragraph 0042. A pin 47 protrudes vertically upward in the central axis of the device 40, the pin 47 being supported at its lower end on a spiral spring 48. Compression of the spring 48 enables the pin 47 to be pushed in the axial direction into the device 40. This is the case in particular if a sleeve-shaped workpiece~~[[not illustrated]]~~ 26' is put over the pin 47 and is pressed together with the pin 47 into the device 40. In the process, a sleeve-shaped workpiece 26' of this type is in contact with the spheres 41 of the outlets of the lubricating oil and presses said spheres into the particular outlets to such an extent that the outlets are opened up and lubricating oil can be discharged. This lubricating oil then wets the surface of the sleeve-shaped workpiece as it is guided past.